



UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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LAHIVE AND COCKFIELD,LLP
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In re Application of :
Vassiliki A. Boussiotis et al :
Serial No.: 08/270,152 : PETITION DECISION
Filed: July 1, 1994 :
Attorney Docket No.: RPI-022 :

This is in response to applicants' petition under 37 CFR 1.181, filed December 16, 1997, to withdraw the finality of the Office action of December 24, 1996.

BACKGROUND

A review of the file history shows that the above identified application was filed July 1, 1994. The examiner mailed a restriction requirement to applicants on October 4, 1995, to which applicants replied on December 6, 1995, by canceling the original claims and presenting a new set of claims with an election. The examiner mailed a first rejection to applicants on March 18, 1996, setting a three month shortened statutory period for reply and rejecting the elected claims for various reasons. Applicants replied on September 20, 1996, amending the elected claims. The examiner mailed a Final Office action to applicants on December 24, 1996, rejecting the elected claims for many of the same reasons as before but modifying the reasons set forth for the rejection under 35 U.S.C. 112, first paragraph. Applicants filed a reply concurrently with a Notice of Appeal and a three month extension of time on June 24, 1997. Applicants argued in the reply that the finality of the rejection was premature. The examiner mailed an Advisory action to applicants on July 17, 1996, indicating entry of the amendment, but maintaining the rejections of record and providing brief comments on the rejections of record. Applicants filed a proper Appeal Brief with a four month extension of time accompanied by a second amendment after Final rejection and a petition to withdraw the finality of the Office action on December 16, 1997. For reasons unknown, the petition was ignored and an Examiner's Answer was prepared and mailed to applicants accompanied by a second Advisory action. Following receipt and acknowledgment of a Reply Brief the application was forwarded to the Board of Appeals. The Board of Appeals remanded the application for decision on the undecided petition and other matters on January 3, 2002.

DISCUSSION

37 CFR 1.181 allows an applicant to petition the Commissioner over any examiner action considered by applicant to be inappropriate.

1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner:

(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;...

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. **Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.**

(g) The Commissioner may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

It is noted in this instance that the examiner's action - issuance of a Final Office action - occurred on December 24, 1996, and was first objected to in the amendment filed with a Notice of Appeal on June 24, 1997. By means of an Advisory action the examiner maintained or repeated the action complained of. Applicants did not further protest the action, issuance of a Final Office action, until this petition was filed on December 16, 1997, nearly six months after the repeated action occurred. As such, the petition is untimely under 37 CFR 1.181(f).

As to the merits of the petition, it is noted that applicants amended the claims in reply to the first Office action which caused the examiner, at least in part, to modify the grounds of rejection applicable. While there may be some disagreement as to the need for some changes in the rejection, the thrust of the rejection complained of is generally similar in both the non-Final and Final rejections.

DECISION

In view of the above, applicant's petition is **DENIED** as untimely and lacking merit.

As the application has been remanded from the Board of Appeals for this and other matters, the application will be forwarded to the examiner for consideration of the remaining matters.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230

John Doll

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